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| EXAMINER | | | | |
| HAQ, NAEEM U | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/827,788

Applicant(s)

KWAN, KHAI HEE

Examiner

Naeem Haq

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33, 34, 37, 38, 40, 41, 44, 45 and 47-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33, 34, 37, 40, 41, 44, 48, 49, 51-54, 56, 57 and 59 is/are rejected.
- 7) ☒ Claim(s) 38, 45, 47, 50, 55, and 58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to the Applicant's After-Final Amendment filed on November 16, 2007. Claims 33, 34, 37, 38, 40, 41, 44, 45, and 47-59 are pending and will be considered for examination.

Applicant's amendment is sufficient to overcome the objection and rejection given in the previous Office Action.

Allowable Subject Matter

The indicated allowability of claims 33, 34, 37, 40, 41, 44, 48-49, 51-54, 56, 57 and 59 is withdrawn in view of the newly discovered reference(s) to Slater (US 7,051,001 B1). Rejections based on the newly cited reference(s) follow.

Claims 38, 45, 47, 50, 55, and 58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including *all* of the limitations of the base claim and *all* intervening claims.

Claim Objections

Claims 34, 41, and 54 are objected to because of the following informalities: These claim recites the phrase "...code *send* to payment processor..." The examiner believes this is a grammatical error. The phrase should recite "...code *sent* to payment..." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33, 34, 37, 38, 40, 41, 44, 45, and 47-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 33, 40, and 53 recite the limitation receiving approval or rejection from the **payee's** carrier provider (e.g. see claim 33, lines 19-21). This limitation lacks proper written description support in the original application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 34, 40, 41, 48, 51, 53, 54, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrill, Jr. (US 5,991,749) in view of Slater (US 7,051,001 B1).

Referring to claim 33: Morrill discloses a computer readable storage medium storing instructions that, when executed by a computer to perform a method for payment or fund transfer transactions, the method comprising:

- providing at least a centralized payment processor linked to networks connecting to at least a telecommunication carrier provider's server (col. 3, lines 27-30: "*If the mobile service provider has established a relationship and computer communication link with a bank clearinghouse, credit card issuer, or other financial institution...debits and credits may instead be performed by those institutions...*") having telecommunication accounts (col. 2, lines 55-57: "*The mobile phone service provider CPU will have a linked record of the customer's pre-authorized financial account numbers...*") and corresponding account identifiers (col. 2, lines 54-55: "*...unique account code representing a specific credit card, debit card, bank, or other financial account.*");
- providing a wireless communication device (col. 2, lines 18-22; col. 3, line 65 – col. 4, line 4);
- the payment processor receiving at least a transfer amount (col. 1, lines 45-47: "*The desired transaction may involve a default amount at a pre-set price or a variable amount in which case such amount is identified and sent to the central processing unit.*"; col. 2, lines 45-50: "*If the transaction involves a variable amount (not a specific transaction with a pre-set default price), such as buying lunch or a souvenir from a street vendor, the CPU prompts the user to enter an amount, "SEND" it, then prompts "OK?" and the user presses "SEND" or clears and re-enters amount.*"; col. 4, lines 58-61: "*...the CPU prompts for an amount to be paid or transferred. In this*

case, the payor has purchased \$4.50 worth of food and drink. He enters that amount and presses SEND. The CPU confirms amount and asks "OK?" and the payor presses SEND or clears and corrects the amount and presses SEND."), a payee's account identifier upon initiation of a transaction over a first network from payer (col. 2, line 63 – col. 3, line 5: "If the transaction type is not linked to a unique destination account by prior agreement between the mobile service provider and the 2nd party, the CPU prompts "PAY TO?" and the user enters the account code to which funds are to be transferred. This destination account code would be a unique vendor code (made known to the user verbally, by signage or by PC display), a unique user account code (in the case of an inter-account transfer by a single party), or the mobile phone number of the recipient.");

- the payment processor receiving at least a payer's account identifier from said payer (col. 1, lines 41-44: "Preferably, the method includes the step of determining at the central processing unit whether a personal identification number is needed, and if so, the central processing unit is supplied with that number."; col. 2, lines 54-55: "...prompts for a unique account code representing a specific credit card, debit card, bank, or other financial account."; col. 4, line 65 – col. 5, line 1: "Depending upon the provisions of the service agreement between the customer and the mobile phone service provider, the CPU may then prompt for an account code, representing the account to be debited.");
- the payment processor receiving at least a password from said payer (col. 2, lines 60-63: "The CPU then determines if the account/transaction protocol requires a personal identification number (PIN). To prevent unauthorized access and, if so, prompts for PIN. User enters PIN and presses "SEND."");

- the payment processor transmitting said payer's account identifier, said password and said amount to said payer's telecommunication carrier provider for authentication (col. 1, lines 36-38; col. 2, line 45 – col. 3, line 11; col. 4, line 48 – col. 5, line 22; lines 43-49);
- the payment processor transmitting said payee's account identifier to said payee's telecommunication carrier provider for authentication (col. 3, lines 11-18; col. 5, lines 29-35; col. 6, lines 7-13);
- the payment processor transmitting to said payer's carrier provider to record a debit entry for said transfer amount in said payer's account and transmitting to said payee's carrier provider to record a credit entry for same for said payee's account (col. 3, lines 22-27; col. 4, lines 17-28, lines 31-38; col. 5, lines 23-35; col. 6, lines 7-13); and
- whereby said payment processor is a single point of contact to process transactions between payer and payee having accounts with different telecommunication carrier providers without said providers communicating with each other over said networks (col. 3, lines 27-35).

Morrill does not teach receiving an approval or rejection from said authentication process from respective said carrier providers of said payer and said payee prior to debiting and crediting. However, Slater teaches this limitation (col. 3, line 51 – col. 4, line 3). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to receive an approval or rejection from the providers prior to crediting and debiting the accounts. One of ordinary skill in the art would have been

motivated to do so in order to confirm that sufficient funds are available for payment, as taught by Salter (col. 3, lines 62-64).

Referring to claim 34: Morrill discloses that the transfer amount and said payee's account identifier is a code sent to a payment processor to identify transaction and payee (col. 2, line 45 – col. 3, line 5).

Referring to claim 48: Morrill teaches a prepaid account (col. 4, lines 17-19). Morrill does not teach verifying availability of prepaid funds. However, Slater teaches this limitation (col. 3, lines 62-64). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the invention of Morrill. One of ordinary skill in the art would have been motivated to do so in order to ensure sufficient funds were available.

Referring to claims 40 and 53: Claims 40 and 53 are rejected under the same rationale as set forth above in claim 33.

Referring to claims 41 and 54: Claims 41 and 54 are rejected under the same rationale as set forth above in claim 34.

Referring to claims 51 and 56: Claims 41 and 54 are rejected under the same rationale as set forth above in claim 48.

Claims 37, 44, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrill, Jr. (US 5,991,749) in view of Slater (US 7,051,001 B1) and further in view of Smith et al. (US 6,487,540 B1) ("Smith").

Referring to claim 37: The cited prior art teaches or suggests all the limitations of claim 33 as noted above. The cited prior art does not teach that the payer's wireless communication device receives from said payee at least one of the following selected from a group consisting of: a receipt evidencing said transfer amount, digital goods and a receipt for services over a wireless network. However, Smith teaches a method for the transmission of an electronic receipt between wireless devices (Abstract; col. 1, lines 5-20; col. 3, lines 15-62). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, for the payee (i.e. vendor) to deliver an electronic receipt the payer (i.e. purchaser). One of ordinary skill in the art would have been motivated to do so in order to provide the payer with documentation of the transaction.

Referring to claims 44 and 57: Claims 41 and 54 are rejected under the same rationale as set forth above in claim 37.

Claims 49, 52, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrill, Jr. (US 5,991,749) in view of Slater (US 7,051,001 B1) and further in view of Erwin et al. (US 6,249,770 B1) ("Erwin").

Referring to claim 49: The cited prior art teaches or suggests all the limitations of claim 33 as noted above. The cited prior art does not teach establishing sub accounts corresponding to a main account. However, Erwin teaches this limitation (col. 8, lines

55-57; col. 10, lines 42-45). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the prior art. One of ordinary skill in the art would have been motivated to do so in order to provide the user with a required level of breakdown, as taught by Erwin.

Referring to claims 52 and 59: Claims 41 and 54 are rejected under the same rationale as set forth above in claim 49.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Naeem Haq/
Primary Examiner, Art Unit 3625

January 30, 2007